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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,029	01/29/2002	Yoshiyuki Sasaki	R2184.0132/P132	2677
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DICKSTEIN SHAPIRO LLP 1825 EYE STREET NW Washington, DC 20006-5403			EXAMINER ORTIZ CRIADO, JORGE L	
			ART UNIT	PAPER NUMBER
			2627	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/058,029	Applicant(s) SASAKI, YOSHIYUKI	
	Examiner JORGE L. ORTIZ CRIADO	Art Unit 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/12/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09/12/2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification /Drawings

The amendment filed 09/12/2008 are objected to under 35 U.S.C. 132(a) because it introduced new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The amendments made to Figures drawings 6- 11, by deletion of subject matter in steps "s3" and "s4", respectively, introduces New Matter., since Applicant is changing the scope which the subject matter which covers a broader invention.

The disclosure, as originally filed, for instance, page 16, regarding fig. 6, do not support a broad meaning for the “the controller checking whether the disc is rotating a speed suitable for the storing and reproducing of the user’s request”.

The written description as originally filed described the “the controller” to be checking whether the disc is rotating at designated by the user”. Which is the only possible checking function described to be performed by the controller, as is the only stated purpose of the description regarding such checking operation, as originally filed.

One skilled in this art would not be taught by the written description of the invention in the specification that any or other functions, not disclosed, of the controller for performing such

Art Unit: 2627

checking, other than the function as originally filed, which regards checking whether the disc is rotating at designated by the user.

The examiner cannot ascertain where in the original specification, including the detailed description, support for these changes to the drawings is found. The description found in the corresponding explanation in the specification, and the drawings interpreted along with the accompanying description, describes at page 6, line 10-21 is as follows:

“Formatting in the background begins (Step S1). The controller 13 checks whether the user requests to store or reproduce data (Step S2). If the user requests to do so (Y branch of S2), the controller 13 further checks whether the disc is rotating at a speed suitable for the storing and reproducing of the user's request (S3). If the disc is not rotating at a speed corresponding to the speed of storage and reproduction designated by the user (N branch of S3), the controller 13 changes the rotating speed of the spindle motor 4 through the rotation control unit 10 (S4)”.

Hence, the supporting description relates to changing the rotation by checking whether the disc is rotating at a speed corresponding to the speed of storage and reproduction designated by the user request (emphasis added), and the controller controls and changes the rotation speed of the spindle motor through a rotation control unit (See for example Figure. 6 step S3 and the description on page 16, lines 6-24).

Hence, the amendment to the figures and specification, represents new matter added to the disclosure, and finds no support in the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims recite the limitations “if the first rotation mode is not suitable for the storing and reproducing of the user request, changing from the first rotating mode to a second rotating mode and writing the user data to the recording medium at the second rotating mode”.

The examiner cannot ascertain where in the specification, including the detailed description and the drawings, support for this limitation is found. The only description found related to changing the rotation is related to the controller checking whether the disc is rotating at a speed corresponding to the speed of storage and reproduction designated by the user request, and the controller controls and changes the rotation speed of the spindle motor through a rotation control unit (See for example explanation for Figure 6, on page 16, lines 6-24).

No determination is made to change from the first rotating mode to a second rotating mode and writing the user data to the recording medium at the second rotating mode, if the first rotation mode is not suitable for the storing and reproducing of the user request.

The currently amended Figures are not considered supporting, because as outlined above the changes introduce new matter added.

The specification describes changing the speed to that is designated by the user, as originally filed. Hence, this new limitation represents new matter in claims.

Response to Arguments

Applicant's arguments filed 09/12/2008 have been fully considered but they are not persuasive.

Applicant argues that the Drawings do not introduce new matter to the Specification, because the amendments were submitted by Applicant to obviate Examiner objection to the original drawings. Applicant argues that the amended drawings modify the labeling on steps S3 and S4 on each of the flow charts of Figs. 6-11 and these changes are fully disclosed by the original specification.

The currently amended Figures are not considered supporting, as outlined above, because the changes introduce new matter.

The specification describes changing the speed to that is designated by the user, as originally filed. Hence, the claim limitation of “if the first rotation mode is **not suitable** for the

Art Unit: 2627

storing and reproducing of the user request, changing from the first rotating mode to a second rotating mode and writing the user data to the recording medium at the second rotating mode”

introduces new matter.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JORGE L. ORTIZ CRIADO whose telephone number is (571)272-7624. The examiner can normally be reached on Mon.-Fri 10:00 am- 6:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Andrea L. Wellington can be reached on (571) 272-4483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jorge L Ortiz-Criado/
Primary Examiner, Art Unit 2627